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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,337	09/26/2006	Bernardus H.W. Hendriks	GB 040076	7124

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EXAMINER

CHOI, WILLIAM C

ART UNIT	PAPER NUMBER
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2873

MAIL DATE	DELIVERY MODE
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09/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/599,337	Applicant(s) HENDRIKS ET AL.	
	Examiner WILLIAM C. CHOI	Art Unit 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-12 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>101007</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The Information Disclosure Statement (IDS), filed on 10/10/2007, was received. An initialized copy of the IDS is enclosed with this office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-8 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Feenstra et al (WO 03/069380 A1).

In regard to claim 1, Feenstra et al discloses an optical element (page 3, line 32 – page 5, line 8, Figure 1), characterized in that it comprises a fluid chamber (Figure 1, “5”), which is provided with an electrode configuration (Figure 1, “2,12”) and includes a first, electrically conducting, fluid (Figure 1, “B”) and a second, non-conducting, fluid (Figure 1, “A”), and an interface (Figure 1, “14”) between the fluid, the fluids inherently

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having different Abbe numbers, this being reasonably assumed from Feenstra disclosing the same fluid materials as that of the current invention (page 4, lines 3-10 compared to page 5, line 31 – page 6, line 4 of the originally filed description or claim 7). Feenstra further discloses the corrective power of the element being controllable by electrowetting forces generated by a voltage (Figures 1-3, “ $V_{1,2,3}$ ”) applied to the electrode configuration (Figure 1, “2,12”) and deforming the shape of the interface (Figures 1-3, “14”).

The recitation “for correcting refractive index related aberrations in an optical system” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Regarding claim 3, Feenstra et al discloses a first electrode (Figure 1, “12”) connected to the first fluid (Figure 1, “B”) and a second electrode (Figure 1, “2”) arranged on the inner side of the fluid chamber wall (page 4, lines 1-2).

Regarding claim 4, Feenstra et al discloses wherein the inner side of the fluid chamber wall facing the fluids is covered by an insulating layer (Figure 1, “8”).

Regarding claim 5, Feenstra et al discloses wherein the insulating (Figure 1, “8”) layer is covered by a hydrophobic layer (Figure 1, “10”).

Regarding claim 6, Feenstra et al discloses wherein the insulating layer is hydrophobic (page 4, lines 16, 17, re: parylene).

Regarding claim 7, Feenstra et al discloses the first fluid is salted water and the second fluid is oil (page 4, lines 3-6).

Regarding claim 8, Feenstra et al discloses an image-capturing device (page 6, line 17 – page 7, line 29, Figure 4) comprising a lens system comprising said optical element (page 7, lines 17-27, Figure 4, “104, 102, 105, 106”) and an image-receiving unit (Figure 4, “120).

Regarding claim 12, Feenstra et al discloses an optical head (page 8, line 3 – page 9, line 2, Figure 5) for scanning an information layer (Figure 5, “206) and comprising a radiation source unit for supplying a scanning beam (page 8, lines 11-13), an optical lens system characterized in that the lens system comprises said optical element (Figure 5, “200, 202, 204”) for focusing the scanning beam in the information layer (Figure 5, “208”) and would inherently comprise a radiation-sensitive detection unit for converting scanning beam radiation from the information layer into electrical signals, this being reasonably assumed from the disclosure of said invention being a device for recording and/or playback from an optical disk (page 8, lines 3-5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feenstra et al as applied to claim 8 above, and further in view of Atarashi et al (US 6,891,679 B2).

Regarding claims 9-11, Feenstra et al discloses as set forth above, but does not specifically disclose said image-capturing device comprised in a mobile phone comprising a camera. Within the same field of endeavor, Atarashi et al teaches that it is well known in the art to utilize electrowetting optics in optical systems used in cell phones and cameras (column 1, lines 16-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made for said image-capturing device of Feenstra et al to be comprised in a mobile phone comprising a camera since Atarashi et al teaches that it is well known in the art to do so.

Allowable Subject Matter

Claims 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach a combination of all the claimed features as presented in claim 2: an optical element as claimed, specifically characterized in that the first and second fluids have substantially the same refractive index.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM C. CHOI whose telephone number is (571)272-2324. The examiner can normally be reached on Monday-Friday from about 9:00 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William C. Choi/
Primary Examiner, Art Unit 2873
September 15, 2008